

Appl. No. 09/710,654
Response dated 11/3/2005
Reply to Office Action of 06/03/2005

AMENDMENTS TO DRAWINGS

The attached sheet of drawings included changes to Fig. 9. This sheet also includes Fig. 8 that is not amended. Fig. 9 has been amended so that there is a link between the Web Page Server and the Media File Server.

Attachment: Replacement Sheet for Figs. 8, 9

REMARKS

Objection to the Specification

The Examiner objects to the title of the invention as being non-descriptive. The title is amended herein to allow for proper classification of the claimed subject matter and complies with 37 C.F.R. 1.72 (See MPEP 606). As stated above the new title is “SYSTEM AND METHOD FOR CREATING AND POSTING MEDIA LISTS FOR PURPOSES OF SUBSEQUENT PLAYBACK.”

Formal Drawings Request

The Examiner requests that the Applicant provide a formal Figure 9. Formal Figure 9 is attached in the Appendix herewith. Figure 9 appears with a link between the “Web Page Server and Media File Server”. Support for this link is found on at least p. 36, ll. 10-24 through p. 37, ll. 1-2:

“Figure 9 is a ... Then, a creator user may include those hyperlinks a web page and uploads the web page 920 onto a server 930 capable of serving the web page. A creator user may also include one or more hyperlinks in any electronic message allowing any recipient equipped with web browsing capability to access the media files. Additionally, a creator user may also include one or more instructions in web pages and messages requesting list of hyperlinks to media files from the media file server.

“According to embodiments, a user using a client computer 940 enabled with web browsing capability may access 950 a web server 930 and download a web page posted by a creator user 960. The web page may contain one or more hyperlinks to media files. The web page may also contain one or more

instructions to download a list of hyperlinks to media files located on the media file server. ...

Claim remarks with regards to 35 U.S.C. §132

The Examiner objects to the amendment filed on April 4th, 2002 under 35 U.S.C. §132 and states under paragraph 5, subparagraph a-h:

- a) *Examiner rejects Figure 9 under 35 U.S.C. §132 as follows - Figure 9 addition of "link between Web Page Server and Media File Server" (is new matter)*

Applicant respectfully disagrees with the Examiner's position that the link between Web Page Server and Media File Server is new matter. Support for this link is found at least on p. 36, ll. 10-24 through p. 37, ll. 1-2:

"Figure 9 is a ... Then, a creator user may include those hyperlinks a web page and uploads the web page 920 onto a server 930 capable of serving the web page. A creator user may also include one or more hyperlinks in any electronic message allowing any recipient equipped with web browsing capability to access the media files. Additionally, a creator user may also include one or more instructions in web pages and messages requesting list of hyperlinks to media files from the media file server.

"According to embodiments, a user using a client computer 940 enabled with web browsing capability may access 950 a web server 930 and download a web page posted by a creator user 960. The web page may contain one or more hyperlinks to media files. The web page may also contain one or more instructions to download a list of hyperlinks to media files located on the media file server. ..."

- b) *Examiner rejects claim 83 under U.S.C. §132 as follows - Newly presented limitations, "media on media server wherein said media is capable of playback*

from said media server”, and “said at least one references are associated for playback as an atomic unit via said mediagram”, of claim 83 (is new matter)

Claim 83 is canceled without prejudice rendering the Examiner’s rejection moot.

c) Examiner rejects claim 88 under U.S.C. §132 as follows - Newly presented limitations, “media on media server wherein said media is capable of playback from said media server”, and “said at least one references are associated for playback as an atomic unit via said mediagram”, of claim 88 (is new matter)

Claim 88 is canceled without prejudice rendering the Examiner’s rejection moot.

d) Examiner rejects claim 107 under U.S.C. §132 as follows - Newly presented limitations, “client plugin generates a unique code for identifying said client plugin to said second computer system”, of claim 107 (is new matter)

Applicant respectfully submits that there is no new matter introduced in claim 107. Support for the elements set forth in claim 107 is found in the following locations in the specification:

generates a unique code:

p. 22, ll. 16-19:

After downloading the plug-in, the plug-in is installed at step 406. During installation, the plug-in registers with the browser and generates a unique code

that is stored in the plug-in computer's system registry for transmission to the server at a later time. ...

e) Examiner rejects claim 112 under U.S.C. §132 as follows - Newly presented limitations, "to enable publication via a web page", of claim 112 (is new matter)

Applicant respectfully submits that there is no new matter introduced in claim 112. Support for these elements is found in the following locations in the specification:

enable publication via:

p. 40, ll. 16-24, p. 41, ll. 1-4.

According to an embodiment, at step 1015, media files are associated with the list entries by a creator. As a result, media content is stored in database and file records. Media content may be stored in different databases or on different servers. Each piece of media content is treated as an atomic unit (e.g. a media file or mediagram) that can be directly linked to via a resource locator (e.g. URL) and served as a link through a page generated from a distribution list. Examples of media content comprise voice messages, Web Clips, pictures, HTML pages, attachments, templates, and imported lists. Templates may be used to collect and post media file or mediagram entries from a resource locator (e.g. URL) link. Imported lists comprise pointers to distribution lists and individual media files or mediagrams kept in another account. Moreover, the creator of the content can give permission to another media file or mediagram account holder to publish the content on other media file or mediagram accounts.

f) Examiner rejects claim 117 under U.S.C. §132 as follows - Newly presented limitations, "obtaining exactly one reference to media on a media server wherein said media is capable of playback from said media server using said reference"

and “references are associated for playback as an atomic unit via said mediagram”, of claim 117 (is new matter)

Claim 117 has been amended to remove the word “exactly”. Applicant respectfully submits that there is no new matter introduced in claim 117. Support for these elements is found in at least the following locations of the patent specification:

media is capable of playback:

p. 7, ll. 10-18:

Upon successful upload of a file, a file management system provides copies and listings of the file to other servers and web sites as approved by the creator of the file and the owner of the servers and/or site owners. For example, once a file is uploaded, the system then incorporates the file information into one or more web site lists and/or server based database. Once a file is incorporated into the databases, any user having access to a database or list, may select that file for retrieval or playback. Hence, the invention allows for media files to be stored to and accessed from one location (e.g. an Internet server) that is accessible from various locations (e.g. Internet clients via an Internet web site).

p. 27, ll. 1-8:

Once a file is incorporated into the databases, any user having access to a database or list, may select that file for retrieval or playback 480. For example, a user could also opt to retrieve one of that a media file similar to the type of file the user wishes to create. In order to find such a file, the user could access web page listing of files advertised to be the same appropriate type. From such listing, the user then selects a file as desired. Further examples of details and parameters related to retrieval and playback are provided in reference to Figure 9.

associated for playback as an atomic unit via said mediagram:

p. 45, ll. 8-18:

Figure 11 is a block diagram that illustrates representation of information mediagrams used in the invention, in accordance with an embodiment of the present invention. A Mediagram is an atomic unit containing a list of attributes that characterize the mediagram, and lists of references to media files and/or reference to other mediagrams. For example, mediagram 1110 contains a list of attributes, a reference to a list and references to media files. Mediagram 1150 is similar to 1110 in that it has a list of attributes but is different in that it has only one list of media files. A third type of mediagram is 1130. In this example, this mediagram associates mediagrams 1110 and 1150. It stores association attributes and the list of associated elements. The association is represented by 1120 and 1140.

g) Examiner rejects claim 130 under U.S.C. §132 as follows - Newly presented limitations, "volunteer peer computer", of claim 130 (is new matter)

Claim 130 has been amended to read "volunteer computer". Support for this term is found at p. 48, l. 23. "... spare bandwidth of the volunteer computers to distribute multimedia websites ..."

h) Examiner rejects claim 131 under U.S.C. §132 as follows - Newly presented limitations, "portable client computer", of claim 131 (is new matter)

Claim 131 has been amended to read "personal client computer", support for which is found in the first paragraph on p. 22:

"According to an embodiment, the user simply creates the media file, performs any desired signal processing, encodes the file at the user's local computer and then connects to the Service Website or local Website on his personal machine and uploads the file to the Website and selects which web sites to list the file with. ..."

Claim remarks with regards to 35 U.S.C. §112, 1st paragraph

The Examiner rejects claims 83, 88, 107, 112, 117, 130 and 131 with respect to 35 U.S.C. §112, 1st paragraph, stating that the claims contain subject matter not found in the specification.

Claims 83 and 88 are canceled herein without prejudice thereby rendering the Examiner's rejection to these claims moot. As set forth above Applicant has shown that the subject matter listed in the 35 U.S.C. §112 rejection section of the office action does exist for these claims as specified in the previous section with respect to 35 U.S.C. §134. Therefore the rejections are moot. For precise locations of the terms "media is capable of playback from", and all other terms rejected under this section, see the previous section with regards to 35 U.S.C. §132. Applicant has not listed the repetitive sections for brevity but instead respectfully asserts the previous 35 U.S.C. §132 arguments against this 35 U.S.C. §112 rejection.

Applicant also respectfully calls the Examiner's attention to the long established rule that exact matches for terms are **NOT** required under 35 U.S.C. §112. See MPEP 1302.01:

There should be clear support or antecedent basis in the specification for the terminology used in the claims. Usually, the original claims follow the nomenclature of the specification; but sometimes in amending the claims or in adding new claims, applicant employs terms that do not appear in the specification. This may result in uncertainty as to the interpretation to be given such terms. See MPEP § 608.01(o). **It should be noted, however, that exact terms need not be used *in haec verba* to satisfy the written description requirement of the first paragraph of 35 U.S.C. 112.**

Eiselstein v. Frank, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976). See also 37 CFR 1.121(e) which merely requires *substantial* correspondence between the language of the claims and the language of the specification.

In addition, see MPEP 2173.05(e):

**A CLAIM TERM WHICH HAS NO ANTECEDENT BASIS IN THE DISCLOSURE
IS NOT NECESSARILY INDEFINITE**

The mere fact that a term or phrase used in the claim has no antecedent basis in the specification disclosure does not mean, necessarily, that the term or phrase is indefinite. There is no requirement that the words in the claim must match those used in the specification disclosure. Applicants are given a great deal of latitude in how they choose to define their invention so long as the terms and phrases used define the invention with a reasonable degree of clarity and precision.

Some level of understanding is inherent in persons of ordinary skill in the art and Applicant respectfully submits that the claims use language that is distinct enough to define to what of ordinary skill in the art the scope of the invention.

Claim remarks with regards to 35 U.S.C. §112, 2nd paragraph

The Examiner rejects claims 83, 88, 89, 94, 95, 96 and 117 under 35 U.S.C. §112, 2nd paragraph.

Claims 83 and 88: Applicant canceled claims 83 and 88 without prejudice rendering the rejection to these claims moot.

Claim 89: Applicant has amended the claims to provide antecedent basis for “said user” and to fix a typographical error.

Claims 94, 95 and 96: Applicant has amended the claims to remove dependence on an antecedent by altering the term “said ranking” to “a ranking”.

Claim 117: Applicant has amended the claims to correct use of plurals that as amended are now in the singular, e.g., “said at least one reference” and provide antecedent basis for “ordered lists comprising said ordered list of items for playback”. In addition, the terms “creator-user” and “user” have been clarified and support for this amendment is found at least in Fig. 3.

Applicant disagrees with the Examiner in that there is insufficient antecedent basis for the term “said media” and “said creator-user”. The first element of claim 117 as amended reads “obtaining a reference to media on a ...”. This first occurrence of the word “media” is the antecedent basis for “said media”. For example, all references to “media server” use “said media server” and all references to “media attributes” use “said media attributes”. This is not indefinite, when “said media” is used, the term refers to “media”. See 2173.05(e):

... If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. *Ex parte Porter*, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992)...

Applicant respectfully submits that one skilled in the art will readily recognize that if a reference to “said media attributes” occurs, that the reference is to “media attributes” not “media”. Likewise, “said creator user” and “said user” refer to “creator user” and “user” respectively. This is not indefinite, it is standard claim drafting practice.

Claim remarks with regards to 35 U.S.C. §103

The Examiner rejects claims 83, 87, 88, 117 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,374,260 (Hoffert ‘260), U.S. Patent No. 6,769,010 (Knapp ‘010) and Mediagram Inc. (a web page). The Examiner also rejects claims 84-86, 89-104, 114, 116, 118-124 under 35 U.S.C. §103(a) as being unpatentable over Hoffert ‘260, Knapp ‘010, and Mediagram Inc. (a web page) in view of U.S. Patent No. 6,675,205 (Meadway ‘205). The remainder of the claims were rejected using these references in view of various other references as referenced by the Examiner.

Claims 83, 87 and 88: These claims have been canceled without prejudice thereby rendering the rejection moot.

Claim 89: Applicant respectfully submits that claim 89 is unobvious pursuant to 35 U.S.C. 103 for at least the following reasons:

In the stated rejection for claim 89 the Examiner only references claim limitations that are not present in the claim; hence the Examiner did not properly reject claim 89 and thus any further communication about claim 89 would be a first action on the merits.

Applicant agrees with the Examiner in that Hoffert '260, Knapp '010 and Mediagram Inc. do not provide for "second set of attributes, a second set of at least one references and references to a third set of ordered lists". However, since claim 89 does not comprise these limitations, it is unclear from the Examiner's rejection how claim 89 is in any way rejected pursuant to the statutory requirements of 35 U.S.C. 103 which require that all claim limitations must be taught or suggested as per MPEP 2143.03:

2143.03 All Claim Limitations Must Be Taught or Suggested

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Since the Examiner has neither allowed claim 89 or properly rejected claim 89, any future action on claim 89 would be a first action on the merits and as such a Final Rejection is not warranted. See MPEP 706.07(a):

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Since claim 89 does not comprise the limitations involved in this rejection, Applicant respectfully submits that claim 89 is allowable. To further the examination process in lieu of a valid rejection against claim 83, it is also shown why the combined references used against claim 83 for example do not comprise the limitations of Applicant's claim 89.

Even if the Examiner had properly rejected Claim 89 under Hoffert '260, Hoffert '260 does not teach, suggest or describe a first computer system is configured to create a mediagram specified by a creator user where the first computer system is configured to transfer the mediagram to the server.

Hoffert '260, for example does not contemplate at least the following limitations: "said first computer system is configured to create a mediagram specified by a creator user" and "wherein said first computer system is configured to publish said mediagram to said server via said communication network."

Hoffert '260 is concerned with downloading previews of media files FROM a server to a client computer. There is no contemplation of transferring a "mediagram comprising said references enabling retrieval or playback of said audio data wherein said mediagram comprises an atomic unit having at least one reference to said audio data and a set of media attributes" TO the server of Hoffert '260. Specifically, Hoffert '260 uses a server array to process media files, Col. 3, ll. 26-29, "Media files are processed by a multi-tier application service comprising logical components including an application

server, a web server, a data base server and a media server”. The “multi-tier application service” creates indexes in an unattended automated fashion without interaction from a creator user.

Likewise, Knapp '010 does not contemplate “said first computer system is configured to create a mediagram specified by a creator user” and “wherein said first computer system is configured to publish said mediagram to said server via said communication network.” Knapp '010 involves quantifying demand for information by ranking, categorizing and distributing content”, as per Col. 2, ll. 30-36.

Mediagram Inc., as cited by the Examiner does not comprise the limitation “an atomic unit having at least one reference to said audio data and a set of media attributes”. The Mediagram Inc., references is a web page printout. There is no definition on the page relating to an atomic unit or any other definition for that matter. Regardless, the Mediagram Inc., web page does not contemplate “said first computer system is configured to create a mediagram” and “wherein said first computer system is configured to publish said mediagram to said server via said communication network.”

Since the references cited do not teach or suggest the limitations described herein separately, even if they are combined they do not add up to Applicant's claim '89. See the MPEP 2143.03 cite listed above. Therefore, the rejection of claim 89 is moot with respect to the references cited (assuming that the Examiner would have properly rejected Claim 89 using the same references applied against Claim 83).

Claim 117: Claim 117 has been rejected using the same references used in rejecting claim 83. In addition, the Examiner has stated that the Hoffert '260 reference also includes a "creator-user".

Applicant can find no mention of a creator user on Col. 6, ll. 28-42 of Hoffert '260 as specified by the Examiner.

It is submitted that the element in Hoffert '260 that is creating indexes is an Application Service running on a server. (See reference above in argument with respect to Claim 89). Since Hoffert does not comprise a "creator user", at least this element of Claim 117 is not found in the references applied against Claim 117.

For the same reasons given with respect to Claim 89 above, the references cited by the Examiner do not contemplate the limitations of Applicant's amended Claim 117. Namely, at least the limitation "transferring said mediagram to said server" is not contemplated by the references. In addition, the other arguments listed above with respect to Claim 89 are not found in Hoffert and the other references applied against Claim 117.

Since the references cited do not teach or suggest the limitations described herein separately, even if they are combined they do not add up to Applicant's claim '89. See the MPEP 2143.03 cite listed above. Therefore, the rejection of claim 89 is moot with respect to the references cited.

Remaining claims: Claims 84-86 have been canceled rendering the rejections to these claims moot. Claims 90-116 depend on claim 89 which has been shown to be unobvious based on the cited references. Therefore applicant respectfully submits that these claims are in condition for allowance. Claims 118-131 depend on claim 117 which has shown to be unobvious based on the cited references. Therefore Applicant respectfully submits that these claims are also in condition for allowance.

Other Amendments

Although Applicant considers such an amendment unnecessary for reasons of patentability Applicant has also amended claims 89, 93, 105, 107, 110, 111, 112, 114 and 115 to clarify that the term "second computer system" refers generally to a "server". Support for this amendment is found at least in Figs. 3, 9 and p. 40, ll. 18-19.

Applicant has added two new dependent claims, claims 132 and 133 that depend on claims 89 and 117 respectfully. The claims are directed to the changing of media attributes and propagation thereof as supported by at least p. 38, ll. 17-19.

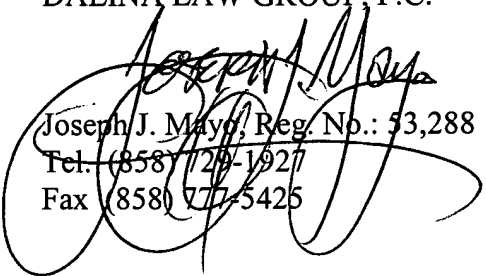
CONCLUSION

Applicant believes that the claims as amended are in condition for allowance. If the Examiner has any questions the Examiner is requested to contact Applicants Representative of Record. This application has been pending for close to 5 years and the Applicant respectfully requests bona fide progress on the merits.

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Respectfully submitted on 11/3/5,

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